

REMARKS/ARGUMENTS

Claims 1-17 are currently pending in which claims 1, 15 and 17 are in independent format. In this response, Claims 1, 4, 5, 7-8 are being amended and claims 2, 3 and 15-17 are being cancelled.

I. Rejection of Claims 1-17 Under 35 U.S.C. § 112

The rejection of claims 1, 15 and 17 is moot, as claim 1 has been amended to remove the rejected claim language of "consisting essentially of" and claims 15-16 have been cancelled. The rejection of claims 1-17 is moot, as claims 1, 4, 5, 7-8 have been amended to address the rejected claim language of "non-rotatable". In particular, claim 1 has been amended to recite that the weight becomes non-rotatable after being internally fastened to the second end of the handle. The Applicant submits that Claim 1 has been amended to avoid any new matter issue as recommended by the Examiner.

II. Rejection of Claims 1-17 under 35 U.S.C. § 103(a)

The rejection of Claims 1-3 and 6-17 under 35 U.S.C. § 103(a) as being allegedly unpatentable by U.S. Patent No. D428,461 (the "*Koszalinski*" reference) in view of U.S. Patent No. 5,215,307 (the "*Huffman*" reference") further in view of U.S. Patent No. 4,272,077 (the "*Spivey*" reference) and further in view of U.S. Patent No. 4,378,113 (the "*Piccini*" reference) is respectfully traversed. The rejection of Claims 4 and 5 under 35

U.S.C. § 103(a) as being allegedly unpatentable by the prior applied to Claim 1 in view of U.S. Patent No. 6,379,261 (the "*Hart*" reference) is respectfully traversed.

A *prima facie* case of obviousness is established when one or more references that were available to the inventor and teach that a suggestion to combine or modify the references, the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art.

Under M.P.E.P. § 706.02(j), three basic criteria must be met for the *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Additionally, prior art may be considered not to teach an invention and thereby may fail to support an obviousness rejection, particularly when the stated objectives of the prior art reinforce such an interpretation. *WMS Gaming Inc., v. International Game Tech.*, 184 F.3d 1339, 51 USPQ2d 1385 (Fed. Cir. 1999).

The *Koszalinski* reference teaches a golf club trainer. A weight of the club trainer slips around an exposed threaded rod wherein external collars position the weight along the exposed threaded rod. The rod, in turn, inserts within a handle of the club trainer. The *Koszalinski* reference does not teach or suggest all of the present claim limitations such as the weight being internally fastened with the second end. In contrast, the *Koszalinski* reference teaches externally fastening the weight on the rod and within opposing collars. During repetitive swinging, however, these collars may slip leading to dangerous conditions. Since the claimed feature of the present application internally fastens the weight to the second end eliminating additional components that may slip, one skilled in the art would not be motivated to seek out the reference due to the external fastening of the weight between the collars as taught by the *Koszalinski* reference.

The *Huffman* reference teaches a training exercise method. The method provides a normal balance to the user while the user swings a counter weighted device. (See: Abstract)(Emphasis added). Applicant respectfully notes that the *Huffman* reference requires opposing and counter balancing weights. In fact, the *Huffman* reference repeatedly emphasizes the objectives of counter balancing weights. (See: Col. 1, lines, 28, 38, 50; and Col. 2, lines 7, 12, 26 and 55). The device as taught by the *Huffman* reference includes a shaft with weights at opposing ends that counter balance

each other. In the background section, the *Huffman* reference discloses that a training device having a weight at only one end of a training device results in the disadvantage of pulling the user toward the weight. (See: Col. 1, lines 10-11).

The *Huffman* reference discloses that a need exists for an exercise method that does not affect the balance of the user while performing the exercise. (See: Col., lines 20-21). Specifically, the *Huffman* reference states that counter balancing of the weights is critical to maintain balance. (See: Col. 1, lines 38-39). In fact, the *Huffman* reference states that the "key is the counter balanced weights at opposite ends of the shaft with one of the weights being between the hands on the grip and the user's body." (See: Col. 2, lines 54-57)(Emphasis added).

In contrast, the present application recites that the device comprises a single weight internally fastened at the second end of the handle while the first end remains weight free. In other words, the single weight of the present application results in an unbalanced force in order to direct the concentration of the effect of the weight to the user's forearm. Furthermore, in order to concentrate the effect of the weight to the user's forearm, the weight must be at the end of the shaft. As such, the weight of the present application is not positioned between the user's hand and the user's body as taught and emphasized by the *Huffman* reference.

Since the present application discloses the weight at the second end of the handle and discloses the first end of the handle as weight free to provide an unbalanced weight, one skilled in the art would not be motivated to seek out the *Huffman* reference due to the required balanced weights and the stated objectives of the *Huffman* reference. As decided by the Federal Circuit, a prior art reference was interpreted not to teach the claimed invention while using the stated objectives described in the prior art to reinforce the interpretation. *WMS Gaming Inc., v. International Game Tech.*, 184 F.3d 1339, 51 USPQ2d 1385 (Fed. Cir. 1999).

As previously, noted, the *Huffman* reference repeatedly emphasizes the objectives of counter balancing weights. Further, the *Huffman* reference specifically teaches that the opposing weights will vary between two and six pounds. (See: Col. 1, lines 50-51). As such, the *Huffman* reference does not clearly serve as a free weighted end as recited by amended Claim 1. Furthermore, the specific teaching of the *Huffman* reference for counter balanced weights leads to a center of mass between the opposing weights. In contrast, amended Claim 1 recites that that the center of mass is positioned within the weight that is fastened with the second end.

The present application teaches that the positioning of the non-rotatable weight, the positioning of its center of mass and the sizing of the handle circumference are configured to direct the effect of the weight in a concentrated manner to the forearms of

the user, as recited in amended Claim 1. (See Specification: page 1, line 22, page 2, lines 8-9 and page 10, lines 22-26). Accordingly, the *Huffman* reference does not teach a suggestion or motivation to modify in order to achieve the present application. The Applicant submits that a *prima facie* case of obviousness has not been achieved.

The *Spivey* reference teaches a golf putter that minimizes putter jerks by preventing the non-dominant hand from overriding the dominant hand. (See: Abstract). The *Spivey* reference teaches keeping the non-dominant hand in its most relaxed muscular condition. (See: Column 1, lines 28-30). This reference uses a formula determined by hand sizes that forces the grip of the non-dominant putting hand to be in a relaxed position so that it does not pull against the putting motion of the dominant hand. (See: Column 1, lines 31-34). As shown in Figs. 4 and 5, a measurement of the golfer's hand is taken to size the distance between the tip of the index finger and the metacarpal phalangeal joint. This measurement is used to determine the circumference of the golf putter grip. (See: Column 2, lines 55-68). By having the non-dominant hand around this sized grip, the non-dominant hand is in the as near as possible relaxed position. (See: Column 3, lines 25-30)(Emphasis added). During use, the dominant hand of the golfer grips the putter tightly while muscles in the non-dominant hand remain relaxed.

In contrast, the claimed features of the present application recite that positioning of the weight and the handle circumference direct the effect of the weight in a concentrated manner to the forearms of the user. In other words, both forearms of the user are flexed (i.e., non-relaxed as stated in the *Spivey* reference). The *Spivey* reference does not provide any suggestion or motivation to modify the reference or to combine reference teachings in order to obtain the claimed features of the present application. The stated objectives of the *Spivey* reference clearly do not provide an interpretation of the claimed features of the present application. (See: *WMS Gaming Inc.*, 184 F.3d 1339 (Fed. Cir. 1999). Accordingly, a *prima facie* case of obviousness has not been achieved.

The *Piccini* reference teaches method of warming up wrists by manipulating a club-like implement having a truncated handle and a body. (See: Column 2, lines 4-6). The body includes a sloping hollow chamber that is partially filled with water. (See: Column 2, lines 6-8; Fig. 2). The implement has an abbreviated handle to prevent the athlete from grasping the implement in the same manner that he would grasp a baseball bat or golf club. (See: Column 2, lines 19-23)(Emphasis added). As taught by the *Piccini* reference, “[b]y providing the abbreviated handle portion, the inventor has provided a device which deliberately makes no effort to simulate the feel of an actual athletic implement.” (See: Column 3, lines 11-13)(Emphasis added). Still further, the

Piccini reference teaches that “[e]ven more importantly, the natural shifting of the flowable material within the device will exert a very natural pull on the athlete’s forearm muscles.” (See: Column 4, lines 30-34). The *Piccini* reference differentiates this pull with other devices that employ shifting of a point mass. (See: Column 4, lines 34-36). Still further, the *Piccini* reference teaches that “the gradual pull of the forearm muscles provided by the shifting of the flowable materials further helps reduce the tendency of an athlete’s muscles in his forearm to become shortened. “ (See: Column 4, lines 42-45).

In contrast, Mr. Pullaro’s invention specifically teaches and claims that the handle is shaped like the grip portion of the implement. As noted, the *Piccini* reference deliberately makes no effort to simulate the feel of an actual athletic implement. Furthermore, the Claim 1 recites that the weight’s shape, the sizing of the circumference of the handle and the positioning of the center of mass are configured to direct the effect of the weight in a concentrated manner to the forearms of the user. Again, as previously noted, the *Piccini* reference specifically differentiates from a point mass force.

The *Piccini* reference specifically teaches away from the Mr. Pullaro’s sport training device. It is improper to combine references when the references teach away from the combination. (See: M.P.E.P. §2145). The *Huffman* reference specifically

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teaches opposing counter weights while the *Piccini* teaches a shifting weight in the form of water. Accordingly, the shifting weight of the *Piccini* teaches away from the combination with the teachings of the Huffman reference. (See also: M.P.E.P. §2143.01 (proposed modification cannot render the prior art unsatisfactory for its intended purpose or change the principle of operation of a reference)).

The reference-by-reference, limitation-by-limitation analysis by the Examiner has not provided a prima facie case of obviousness. The Applicant respectfully requests the Examiner to comment on the Applicant's DVD presentation that was provided in a previous response. As noted in the DVD illustrating a prototype video relating to the application, the experts repeatedly assert that speed and power come from the forearms (See also: video presentation which highlights forearm strength exercises). Furthermore, as shown in the video presentation, the claimed feature of the single weight positioned at the end of the end the second end allows the user to swing the device near the body of the user.

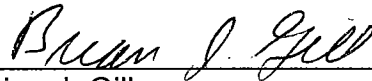
It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present applicant is in condition for allowance.

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Entrance of the amendment and passage of the case to issue are therefore respectfully requested. If the Examiner believes that personal communication will expedite prosecution of the application, the Examiner is invited to telephone the undersigned at (314) 238-2400.

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Respectfully submitted,

A handwritten signature in cursive script, reading "Brian J. Gill", written over a horizontal line.

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